

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. BARKER

Appeal No. 98-1234
Application No. 08/516,214¹

ON BRIEF

Before CALVERT, COHEN, and MEISTER, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

Richard L. Barker (the appellant) appeals from the final rejection of claims 1-10, 21-25, 27 and 28. Claims 26 and 29, the only other claims present in the application, have been

¹ Application for patent filed August 17, 1995.

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indicated as being allowable subject to the requirement that they be rewritten to include all the subject matter of the claims from which they depend.

We REVERSE.

The appellant's invention pertains to a paint brush. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Marick 1947	2,426,315	Aug. 26,
Ela 1959	2,914,785	Dec. 1,
Kaplan 1974	3,831,218	Aug. 27,

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kaplan in view of Marick. According to the examiner it would have been obvious to provide an outer coating of relatively soft elastomeric material on the brush of Kaplan in view of the teachings of Marick.

Claims 8-10, 21-25, 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kaplan in view of Marick and Ela. The examiner is further of the opinion that

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it would have been obvious to provide the brush of Kaplan, as modified by Marick, with an opening in the head portion in view of the teachings of Ela.

The arguments of the appellant and examiner in support of their respective positions are found on pages 5-15 of the brief and pages 6-9 of the answer.

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and the examiner in the answer, it is our conclusion that the above-noted rejections are not sustainable. In rejecting claims under 35 U.S.C. 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. *Id.* If the examiner fails to establish a **prima facie** case, the rejection

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is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Here, even if the references were combined in the manner proposed by the examiner, the claimed invention would not result. More specifically, independent claims 1 and 27 each expressly requires (1) "an outer coating of relatively soft elastomeric material **completely surrounding the core**" (emphasis ours) and (2) "fasteners extending through the ferrule **and outer coating** into the core of the handle" (emphasis ours). There is simply nothing in the combined teachings of the relied on prior art which would fairly suggest either of these limitations.

With apparent reference to limitation (1), the answer on page 4 states that "[s]ince the wooden core of the brush of Marick can be dipped into the rubber (Column 3; Line 15), Kaplan's device, once modified, would have the elastomeric material completely surrounding the core." We do not agree that Marick either teaches or fairly suggests that the elastomeric material **completely surround** the core of the handle as the examiner appears to believe. Marick in column

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2, lines 1-15, makes it clear that a **brush** (i.e., a completed article) having a wooden handle, metal ferrule and bristle portion "of usual construction, [which] may be purchased on the market" is the article to which the elastomeric material is applied. Marick then goes on to state that:

The wooden handle **10** may be coated with a rubber composition such as given in the above example. However, for coating the **handle portion of the brush** it is deemed preferable to employ the conductive properties of acetylene black used as a varnish, lacquer or other synthetic resin coating. . . . This coating may be applied to the brush handle by painting, spraying, or dipping and in the case of the brush shown in Fig. 1, it is important that the coating upon both the bristles and the handle be so applied that the coating shall reach or over-lap the metal ferrule of the brush so as to form a continuous conducting path from the bristles to the brush handle. [Column 2, line 55 through column 3, line 21; emphasis ours.]

From the above, when considering the teachings of Marick as a whole, it is apparent that Marick teaches applying the elastomeric outer coating to the handle of a **completed brush** (which may be purchased on the market). When the handle of such a completed brush is "dipped" in the manner described by Marick, neither of the above-noted limitations (1) or (2) would be satisfied. In other words, (a) only the portion of

the core of the handle extending above the ferrule (see Fig. 1) would be "surrounded" by the outer coating (as distinguished from "completely surrounding the core" as claimed and (b) the fastener would not, as claimed, extend "through the ferrule and outer coating" In this latter regard, it should be noted that even if the entire brush of Marick was "dipped" in the elastomeric material, the outer coating of elastomeric material would cover the ends of the fasteners depicted in Fig. 1 (as distinguished from the claimed arrangement of the fasteners extending through the outer coating).

We have carefully reviewed the teachings of Kaplan and Ela but find nothing therein which either teaches or suggests the above-noted limitations (1) and (2).

Since (a) none of the relied on prior art either teaches or suggests limitations (1) and (2) and (b) the examiner has provided no convincing line of reasoning as to why such limitations would have been obvious (***see Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985)), we will not sustain the rejections of claims 1-10, 21-25, 27 and 28 under 35 U.S.C.

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§ 103.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JAMES M. MEISTER)	
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